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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Akseli Anttila

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EXAMINER

UBER, NATHAN C

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/518,686	Applicant(s) ANTTILA ET AL.	
	Examiner NATHAN C. UBER	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 26 February 2009.
2. Claims 1, 19, 26, 27, 29, 31 and 32 have been amended.
3. Claims 24-26 are canceled.
4. Claims 1-23 and 27-32 are currently pending and have been examined.

Continued Examination Under 37 CFR 1.114

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 February 2009 has been entered.

Claim Objections

6. The previous objection of Claim 30 is withdrawn.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claims 23 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim element "means for utilizing" of claim 23 and claim elements "means for initiating" and "means for associating" of claim 32 are means plus function limitations that invoke 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the

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corresponding structure or material for the claimed functions. Page 12, lines 19-21 briefly discloses that an "application" utilizes the program guide; however application is broadly interpreted to mean software not hardware. Page 26, lines 1-5 discloses that a person (manager) generates the promotion message; however a person is not a structural component. Page 4, line 16 and page 8, line 4 disclose a register that completes the "associating," and page 19, line 24 discloses that a database completes the "associating," however registers and databases are software not hardware. Page 27, lines 18-19 discloses that a signal completes the "associating;" however signals are not physical components. Therefore the means plus function elements are indefinite because there is no corresponding structure in the specification for the claimed functions. Applicant is required to:

- (a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- (b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

- (a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or
- (b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP 2181 and 608.01(0).

Claim Rejections - 35 USC § 101

9. Claims 16-19, 29 and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 16-19, 29 and 30 fail to meet the above requirements because they do not transform underlying subject matter, and because the only steps in the claimed methods that are arguably tied to a particular machine are considered insignificant extra-solution activity. Based on precedent from the *Diehr* (450 U.S. at 191-92) and *Flook* (437 U.S. at 590) Courts "...even if a claim recites a specific machine or a particular transformation of a specific article, the recited machine or transformation must not constitute mere insignificant postsolution activity." *In re Bilski*, 545 F.3d 943, at 957. Further the *Bilski* decision notes that "postsolution activity" is not narrowly interpreted to mean only a step occurring at the end of a process. Rather, based on precedent from *In re Schrader* (22 F.3d 290) and *In re Grams* (888 F.2d 835), insignificant extra-solution activity is applicable to insignificant steps whether occurring pre-solution, post-solution, or in the middle of the process. *Id.* Specific examples of insignificant activity include data recordation or data gathering steps. *Id.* Such steps are incapable of imparting patent-eligibility under § 101. *Id.* Examiner determined that the *sending, receiving, associating* and *forwarding* of claims 16-19, 29 and 30 constitute insignificant extra-solution activity because the steps constitute mere data transmission or recordation. Accordingly, claims 16-19, 29 and 30 are unpatentable under 35 U.S.C. 101 because the insignificant extra-solution steps are the only steps that include a specific machine or particular transformation and because the insignificant

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extra-solution steps are incapable of imparting patent-eligibility under § 101. (For further guidance see also the USPTO Memorandum "Guidance for examining Process Claims in view of *In re Bilski*" dated 7 January 2009).

10. Claim 19 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 19 is directed to a communication terminal, which is customarily considered a device/machine; however the body of the claim is directed only to software modules not to physical machine/device components. Therefore Examiner interprets the *communication terminal* of claim 19 to be in fact purely software. Software is *per se* not patentable subject matter because it is not one of the enumerated statutory classes of invention under 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

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and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

- 14. Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
- 15.** Claims 1-18, 27-29, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strietzel (U.S. 2001/0051517) in view of Reese (U.S. 2003/0191685 A1).

Claim 1:

Strietzel, as shown, discloses the following limitation:

- *a promotion server configured to send a promotion message associated with an event having a defined start time to one or more communication terminals through at least one communication network in response to receiving a promotion message request from an event manager* (see at least ¶0007, "[t]he telecommunications advertising means comprises an advertisement database and a processing means," see also at least ¶0041, and ¶0056 and figure 8).

The Strietzel invention does not specifically disclose *promotion message associated with an event having a defined start time*. Although the content of a promotion message does not patentably affect the scope of the invention and therefore deserves no patentable weight, as claimed the promotion message is "associated" with an event and the association is not necessarily limited to information about the event. The "association" remains ambiguous, however Examiner recognizes that Applicant attempted to narrow

and more clearly define the invention by adding this limitation to the "promotion message," so Examiner will apply patentable weight to the limitation. Reese, as shown, discloses *promotion message associated with an event having a defined start time and reminders* (see at least ¶¶0015-0016, "[t]he user is contacted at the appropriate time and destination with a message containing information associated with the event [t]his information may include a reminder about the event and/or information regarding a product, service, or other events associated with the event"). It would have been obvious to one having ordinary skill in the art at the time of the invention to integrate all of the functionality of the Reese invention with the invention of Strietzel since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Particularly, both inventions are focused on using any communications means to target appropriate messages to a user.

Further, Strietzel, as shown, discloses the following limitations:

- *said promotion server further being configured to receive an acceptance signal relating to the sent promotion message from one or more communication terminals through said at least one communication network* (see at least ¶0055, "[in]...a cellular network, or a paging network can stay on after the communication transaction is over and receive options or a menu allowing the party to select to receive more information about a particular product or service... the user can actually select to be connected directly to the company offering the products or service"),
- *said promotion server comprising a register for associating an accepting communication terminal of said one or more communication terminals with said promotion message, on reception of said acceptance signal from said accepting communication terminal,* (see at least ¶0042, "...processing

means selectively associates at least one advertisement with the source and/or destination of the communication based on the information determined,” “an advertisement may be associated with the destination terminal;” see also at least ¶0059),

- *said promotion server further being configured to communicate a reminder signal for said event to said accepting communication terminal through said first communication network* (see at least ¶0007, “[t]he telecommunications advertising means comprises an advertisement database and a processing means”),
- *wherein said event manager is separate from the one or more communication terminals* (Examiner interprets the event manager broadly, based on the page 14, lines 26-28 of the specification, to be a person that promotes events, see at least ¶0042, source and destination are different entities).

Claim 2:

The combination Strietzel/Reese discloses the limitations as shown in the rejection above. Further, Strietzel, as shown, discloses the following limitation:

- *said one or more communication terminals comprise at least one of mobile phones, cellular phones, personal office assistants or personal computers* (see at least ¶0056, “[t]he device could be, for example, a telephone, cellphone, PDA, or computer...”).

Claim 3:

The combination Strietzel/Reese discloses the limitations as shown in the rejection above. Further, Strietzel, as shown, discloses the following limitation:

- *said promotion message comprises at least one of a text, a series of texts, a picture, a series of pictures, a video sequence, a series of video sequences, an audio track or a series of audio tracks* (see at least ¶0038, “the

advertisement may be an audio advertisement, it may be a jingle, a textual message, a video message, a graphic message, or a combination of these messages depending on the desired implementation").

Claim 4:

The combination Strietzel/Reese discloses the limitations as shown in the rejection above. Further, Strietzel, as shown, discloses the following limitation:

- *said one or more receivers comprise at least one of a television, a radio, a set-top box, a receiver module for a computer, a multimedia terminal, a mobile or cellular phone, a personal office assistant or a personal computer (see at least ¶0056, "[t]he device could be, for example, a telephone, cellphone, PDA, or computer...").*

Claim 5:

The combination Strietzel/Reese discloses the limitations as shown in the rejection above. Further, Strietzel, as shown, discloses the following limitation:

- *said promotion message request comprises at least one of start time, end time of said event, duration of said event, event identity, event type, event presentation platform, promotion message or list of said receivers and said one or more communication terminals (see at least ¶0042, "...processing means selectively associates at least one advertisement with the source and/or destination of the communication based on..." "...destination, type of communication, time of day, etc...").*

Claim 6:

The combination Strietzel/Reese discloses the limitations as shown in the rejection above. Further, Strietzel, as shown, discloses the following limitation:

- *said event presentation platform comprises at least one of the following connected to a media communication network and a network broadcaster: television, a radio, a set-top box, a receiver module for a computer, a*

multimedia terminal, a mobile or cellular phone, a personal office assistant or a personal computer (see at least ¶0056, “[t]he device could be, for example, a telephone, cellphone, PDA, or computer...”).

Claim 7:

The combination Strietzel/Reese discloses the limitations as shown in the rejection above. Further, Strietzel, as shown, discloses the following limitation:

- *said media communication network comprises at least one of a cable television network, a satellite television network, a radio frequency television network, a telephone network, a powerline network, or a radio network* see at least ¶0056, “[t]he device could be, for example, a telephone, cellphone, PDA, or computer...”).

Claim 8:

The combination Strietzel/Reese discloses the limitations as shown in the rejection above. Further, Strietzel, as shown, discloses the following limitation:

- *said first communication network comprises at least one of a wired telecommunication network, a wireless telecommunication network, local area network, metropolitan area network, wide area network, or inter-network such as the Internet or a dedicated communication line* (see at least ¶0025, fixed telecommunications network).

Claim 9:

The combination Strietzel/Reese discloses the limitations as shown in the rejection above. Further, Strietzel, as shown, discloses the following limitation:

- *said connection comprises at least one of wired telecommunication network, a wireless telecommunication network, local area network, metropolitan area network, wide area network or a dedicated communication line* (see at least ¶0025, fixed telecommunications network).

Claim 10:

The combination Strietzel/Reese discloses the limitations as shown in the rejection above. Further, Strietzel, as shown, discloses the following limitations:

- *a storage device configured to store said register, said reminder and said promotion message* (see at least ¶0021, “[a]dvertisement database stores advertisements that can be played),
- *a processor configured to process communication with said one or more communication terminals, configured to process said promotion message request from said event manager, and to update information in said storage device* (see at least ¶0042, “...processing means selectively associates at least one advertisement with the source and/or destination of the communication based on the information determined”).

Claim 11:

The combination Strietzel/Reese discloses the limitations as shown in the rejection above. Further, Strietzel, as shown, discloses the following limitations:

- *said register comprises at least one of promotion message identity* (see at least ¶0021, “[a]dvertisement database stores advertisements that can be played to system users at appropriate times based on appropriate criteria”),
- *one or more communication terminal identities* (see at least ¶0021, “[a]dvertisement database stores advertisements that can be played to system users at appropriate times based on appropriate criteria”),
- *event data* (see at least ¶0021, “[a]dvertisement database stores advertisements that can be played to system users at appropriate times based on appropriate criteria”),
- *time data or* (see at least ¶0021, “[a]dvertisement database stores advertisements that can be played to system users at appropriate times based on appropriate criteria”),

- *group application data* (see at least ¶0021, “[a]dvertisement database stores advertisements that can be played to system users at appropriate times based on appropriate criteria”).

Claim 12:

The combination Strietzel/Reese discloses the limitations as shown in the rejection above. Further, Strietzel, as shown, discloses the following limitation:

- *said one or more communication terminals is configured to forward said promotion message to further communication terminals connected in said first communication network* (see at least ¶0081, “[i]n one embodiment, advertisements received on a terminal can be forwarded to all or some of the stored phone numbers”).

Claim 13:

The combination Strietzel/Reese discloses the limitations as shown in the rejection above. Further, Strietzel, as shown, discloses the following limitations:

- *wherein an accepting communication terminal of said further communication terminals is configured to respond to said promotion message by communicating an acceptance signal through said first communication network to said promotion server* (see at least ¶0055, “[in]...a cellular network, or a paging network can stay on after the communication transaction is over and receive options or a menu allowing the party to select to receive more information about a particular product or service... the user can actually select to be connected directly to the company offering the products or service”),
- *said promotion server is further configured to associate said accepting communication terminal of said further communication terminals with said promotion message on reception of said acceptance signal from said accepting communication terminal* (see at least ¶0042, “...processing means

selectively associates at least one advertisement with the source and/or destination of the communication based on the information determined”),

- *said promotion server being adapted to communicate a reminder signal to said accepting communication terminal through said first communication network (see at least ¶0007, “[t]he telecommunications advertising means comprises an advertisement database and a processing means”).*

Claim 14:

The combination Strietzel/Reese discloses the limitations as shown in the rejection above. Further, Strietzel, as shown, discloses the following limitations:

- *an accepting communication terminal of said further communication terminals is configured to respond to said promotion message by communicating an acceptance signal through said first communication network to said one or more communication terminals (see at least ¶0055, “[in]...a cellular network, or a paging network can stay on after the communication transaction is over and receive options or a menu allowing the party to select to receive more information about a particular product or service... the user can actually select to be connected directly to the company offering the products or service”),*
- *said one or more communication terminal further comprising a local register configured to associate an accepting communication terminal of said further communication terminals with said promotion message on reception of said acceptance signal from said accepting communication terminal (see at least ¶0042, “...processing means selectively associates at least one advertisement with the source and/or destination of the communication based on the information determined”),*
- *said one or more communication terminals being configured to communicate a reminder signal to said accepting communication terminal through said first*

communication network (see at least ¶0007, “[t]he telecommunications advertising means comprises an advertisement database and a processing means”).

Claim 15:

The combination Strietzel/Reese discloses the limitations as shown in the rejection above. Further, Strietzel, as shown, discloses the following limitation:

- *said one or more communication terminals are configured to start a predetermined application when receiving said reminder signal* (see at least ¶0038, “the advertisement may be an audio advertisement, it may be a jingle, a textual message, a video message, a graphic message, or a combination of these messages depending on the desired implementation”).

Claims 16, 29, 31 and 32:

Strietzel, as shown, discloses the following limitations:

- *initiating a promotion message via an event manager* (see at least ¶0007, “[t]he telecommunications advertising means comprises an advertisement database and a processing means,” the Strietzel disclosure further includes numerous triggering events that initiate the processing means),
- *forwarding a promotion message request to a promotion server* (see at least ¶0007, “[t]he telecommunications advertising means comprises an advertisement database and a processing means,” the Strietzel disclosure further includes numerous triggering events that initiate the processing means),
- *receiving an acceptance signal relating to the sent promotion message from an accepting communication terminal of said one or more communication terminals via said promotion server* (see at least ¶0042, “...processing means selectively associates at least one advertisement with the source and/or destination of the communication based on the information

determined”, acceptance signal is broadly interpreted here to mean a signal that a communication line is established (i.e. signal received), as shown in the cited paragraph once communication is established the promotion server determines which advertisement to route to the users devices and how best to route it, see also ¶0061, users are able to respond to a received advertisement, this response signal is received by the system and the user is connected to the advertiser),

- *associating said accepting communication terminal with said promotion message on reception of said acceptance signal from said accepting communication terminal via a register of said promotion server* (see at least ¶0042, “...processing means selectively associates at least one advertisement with the source and/or destination of the communication based on the information determined”, *acceptance signal* is broadly interpreted here to mean a signal that a communication line is established (i.e. signal received), as shown in the cited paragraph once communication is established the promotion server determines which advertisement to route to the users devices and how best to route it, see also ¶0061, users are able to respond to a received advertisement, this response signal is received by the system and the user is connected to the advertiser),
- *sending a reminder for said event to said accepting communication terminal through said first communication network via said promotion server* (see at least ¶0007, “[t]he telecommunications advertising means comprises an advertisement database and a processing means,” see also at least ¶0065 “[t]he user may even be able to select that more information or similar advertisement sources be provided;” Examiner notes that patentable weight was not given to the “reminder signal” because examiner identified prior art capable of sending signals to terminals and the content of the signals does

not affect the scope of the claims, examiner also notes that weight was not given to the “signal” only the action of transmitting a signal),

- *sending said promotion message associated with an event having a defined start time to one or more communication terminals via a promotion server connected to said one or more communication terminals through a first communication network* (see at least ¶0007, “[t]he telecommunications advertising means comprises an advertisement database and a processing means”),
- *wherein said event manager is separate from the one or more communication terminals* (Examiner interprets the event manager broadly, based on the page 14, lines 26-28 of the specification, to be a person that promotes events, see at least ¶0042, source and destination are different entities).

The Strietzel invention does not specifically disclose *promotion message associated with an event having a defined start time*. Although the content of a promotion message does not patentably affect the scope of the invention and therefore deserves no patentable weight, as claimed the promotion message is “associated” with an event and the association is not necessarily limited to information about the event. The “association” remains ambiguous, however Examiner recognizes that Applicant attempted to narrow and more clearly define the invention by adding this limitation to the “promotion message,” so Examiner will apply patentable weight to the limitation. Reese, as shown, discloses *promotion message associated with an event having a defined start time* (see at least ¶¶0015-0016, “[t]he user is contacted at the appropriate time and destination with a message containing information associated with the event [t]his information may include a reminder about the event and/or information regarding a product, service, or other events associated with the event”). It would have been obvious to one having ordinary skill in the art at the time of the invention to integrate all of the functionality of the

Reese invention with the invention of Strietzel since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Particularly, both inventions are focused on using any communications means to target appropriate messages to a user.

Claim 17:

The combination Strietzel/Reese discloses the limitations as shown in the rejection above. Further, Strietzel, as shown, discloses the following limitations:

- *forwarding said promotion message to further communication terminals via said one or more communication terminals* (see at least ¶0081, "[i]n one embodiment, advertisements received on a terminal can be forwarded to all or some of the stored phone numbers").

Claim 18:

The combination Strietzel/Reese discloses the limitations as shown in the rejection above. Further, Strietzel, as shown, discloses the following limitations:

- *accepting said promotion message by transmitting an acceptance signal to said one or more communication terminals via said further communication terminals* (see at least ¶0042, "...processing means selectively associates at least one advertisement with the source and/or destination of the communication based on the information determined", acceptance signal is broadly interpreted here to mean a signal that a communication line is established (i.e. signal received), as shown in the cited paragraph once communication is established the promotion server determines which advertisement to route to the users devices and how best to route it, see also ¶0061, users are able to respond to a received advertisement, this response signal is received by the system and the user is connected to the advertiser),

- *receiving said acceptance signal from an accepting communication terminal of said further communication terminals via said one or more communication terminals* (see at least ¶0042, "...processing means selectively associates at least one advertisement with the source and/or destination of the communication based on the information determined", acceptance signal is broadly interpreted here to mean a signal that a communication line is established (i.e. signal received), as shown in the cited paragraph once communication is established the promotion server determines which advertisement to route to the users devices and how best to route it, see also ¶0061, users are able to respond to a received advertisement, this response signal is received by the system and the user is connected to the advertiser),
- *associating said accepting communication terminal with said promotion message on reception of said acceptance signal from said accepting communication terminal via a local register of said one or more communication terminal* (see at least ¶0042, "...processing means selectively associates at least one advertisement with the source and/or destination of the communication based on the information determined", acceptance signal is broadly interpreted here to mean a signal that a communication line is established (i.e. signal received), as shown in the cited paragraph once communication is established the promotion server determines which advertisement to route to the users devices and how best to route it, see also ¶0061, users are able to respond to a received advertisement, this response signal is received by the system and the user is connected to the advertiser),
- *transmitting a reminder signal for said event to said accepting communication terminal through said first communication network by means of said one or more communication terminal* (see at least ¶0007, "[t]he telecommunications

advertising means comprises an advertisement database and a processing means,” see also at least ¶0065 “[t]he user may even be able to select that more information or similar advertisement sources be provided,” Examiner notes that patentable weight was not given to the “reminder signal” because examiner identified prior art capable of sending signals to terminals and the content of the signals does not affect the scope of the claims, examiner also notes that weight was not given to the “signal” only the action of transmitting a signal).

Claim 27:

Streitzel, as shown, discloses the following limitation:

- *a messaging module configured to receive a promotion message from a promotion server, the promotion message being associated with an event* see at least ¶0056, “[t]he device could be, for example, a telephone, a cellphone, PDA, or computer...”),

The Strietzel invention does not specifically disclose *promotion message associated with an event*. Although the content of a promotion message does not patentably affect the scope of the invention and therefore deserves no patentable weight, as claimed the promotion message is “associated” with an event and the association is not necessarily limited to information about the event. The “association” remains ambiguous, however Examiner recognizes that Applicant attempted to narrow and more clearly define the invention by adding this limitation to the “promotion message,” so Examiner will apply patentable weight to the limitation. Reese, as shown, discloses *promotion message associated with an event having a defined start time* (see at least ¶¶0015-0016, “[t]he user is contacted at the appropriate time and destination with a message containing information associated with the event [t]his information may include a reminder about the event and/or information regarding a product, service, or other events associated with the event”). It would have been obvious to one having ordinary skill in the art at the time of

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the invention to integrate all of the functionality of the Reese invention with the invention of Strietzel since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Particularly, both inventions are focused on using any communications means to target appropriate messages to a user.

Further, Streitzel, as shown, discloses the following limitations:

- *communication circuitry configured to transmit an acceptance signal based on information in at least one of a calendar or a list of scheduled events residing in the apparatus* see at least ¶0056, “[t]he device could be, for example, a telephone, a cellphone, PDA, or computer...”),
- *communication circuitry configured to receive a reminder signal from said promotion server* see at least ¶0056, “[t]he device could be, for example, a telephone, a cellphone, PDA, or computer...”).

Claim 28:

Streitzel, as shown, discloses the following limitation:

- *communication circuitry configured to forward said promotion message to one or more other apparatuses* (see at least ¶0081, forwarding a promotion message).

16. Claims 19-23 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strietzel (U.S. 2001/0051517) alone.

Claim 19:

Strietzel, as shown, discloses the following limitations:

- *a messaging module configured to receive a promotional message through a first communication network* (see at least Figure 1, 106 Router),
- *a calendar module configured to enable a user of said apparatus terminal to perform general calendar operations* (see at least Figure 1, 102 Message

Database) based on Applicant's definition of *calendar operations*, see 35 U.S.C. 112 rejections above, it would have been obvious to one of ordinary skill in the art at the time of the invention to include additional data such as *calendar operations* within the message database because this will provide a central location for all data pertaining to advertisements and thus faster access to necessary data and improved functionality,

- *a media playback module configured to output promotion message* (see at least Figure 1, 106 Router),
- *a storage module configured to store promotion message information* (see at least Figure 1, 102 Message Database),
- *and a promotion messaging module configured to transmit said promotion message* (see at least Figure 1, 106 Router).

Claim 20:

Strietzel, as shown, discloses the following limitations:

- *wherein said promotion message information comprises at least one of promotion message identity, one or more communication terminal identities, event data or group application data* (see at least ¶0021, "[a]dvertisement database stores advertisements that can be played to system users at appropriate times based on appropriate criteria").

Claim 21:

Strietzel, as shown, discloses the following limitations:

- *audio and visual components configured to communicate the promotion message to the user of the apparatus* (see at least ¶0038, "the advertisement may be an audio advertisement, it may be a jingle, a textual message, a video message, a graphic message, or a combination of these messages depending on the desired implementation" and see at least ¶0056, "[t]he device could be, for example, a telephone, a cellphone, PDA, or

computer..."). Although Strietzel does not specifically require or disclose a audio and visual components, Strietzel contemplates such devices being present in a given receiver depending on the receiver and the supporting network.

Claim 22:

Strietzel, as shown, discloses the following limitations:

- *said storage module is configured to store a promotion message and identity information comprising transmitter identity and associated messaging contact information, recipient identity and associated messaging contact information, media event information and group application data (see at least Figure 1, 102 Message Database),*
- *which data is configured to initialize and activate a reminder application in response to receiving said reminder signal on said apparatus (see at least Figure 1, Item 104 Processing Means).*

Claim 23:

Strietzel, as shown, discloses the following limitation:

- *a means for utilizing an electronic program guide containing information on media events, said utilizing means being configured to cooperate with said calendar module to provide a reject signal when said apparatus is busy (see at least Figure 1, 104 Processing Means).*

Claim 30:

Strietzel, as shown, discloses the following limitation:

- *forwarding said promotion message to one or more other apparatuses (see at least ¶0081, forwarding a promotion message).*

Response to Arguments

17. Applicant's arguments filed 26 February 2009 have been fully considered but they are not persuasive. Applicant presents five arguments regarding claim 1 alleging, generally, that Examiner misconstrued the limitations in claim 1, and that based on Applicant's claim construction Strietzel does not teach the claimed features. Each such argument is addressed below. Applicant is reminded that Examiner applied the broadest reasonable interpretation in light of the specification to the claim language (MPEP 2111). Applicant claims that Strietzel does not disclose many features of claim 1 as listed below, however it is noted that many of the features upon which applicant relies are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
18. Applicant first argues "Strietzel is silent as to sending of a promotion message from a promotion server to one or more communication terminals... as claimed" (see page 14 of Applicant's response). Examiner notes that Strietzel discloses in ¶0007, "[t]he telecommunications advertising means comprises an advertisement database and a processing means," and further elaborates the in ¶0041, ¶0056 and figure 8. Strietzel discloses an advertisement database that stores advertisements to send to communication terminal users. Strietzel may not use the word "send" however the advertisement database is clearly not the same as a terminal, thus the messages inherently must be "sent" from the database to the terminal. Applicant argues that the Strietzel invention is different because the advertisement is played to a user that is a calling party. If this were true, Streitzel would still teach this claim limitation because the claim is silent on how the message is sent, and further because Applicant explicitly states in the specification that the promotion message may be an "audio track" (see page 15, line 30 of the specification) and Applicant states that the "system may be implemented in accordance with any communication guidelines or standards" (page 6, lines 11-22), thus Examiner's interpretation of a "phone call" as satisfying the communication terminal (phone) and communication network (telephone network) is reasonable in light of the specification. However Applicant's assessment and narrow reading of

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Strietzel is not accurate because Strietzel also indicates that advertising messages are not limited to audio, but may also be visual (see at least ¶0051, text capabilities, see also ¶0059, email). Applicant also argues that the promotions in Strietzel are not sent in response to a message request. However, promotion message request is broadly construed to mean an advertiser requesting an advertisement be sent or a user requesting to receive ads. In both cases Strietzel teaches these limitations. Inherently the presence of an advertisement database indicates that advertisers contributed ads intended to subsequently be distributed. Further in at least ¶0049 users can supply preferences to help the Strietzel invention properly target ads to users.

19. Next Applicant argues that “Strietzel is silent as to an event manager or any such manager sending requests to the promotion server” and that “Strietzel is silent as to an event manager being separate from the one or more communication terminals” (see page 14 of Applicant’s response). Examiner interprets *event manager* to mean a person that is promoting an event based on Applicant’s specification (see page 14, lines 25-28), further Examiner interprets the various terminals to be devices such as phones as suggested by both Applicant and Strietzel. As noted in the preceding paragraph, Strietzel discloses that advertisers contribute ads to the advertisement database for distribution (see at least item 802 and ¶0056 of Strietzel). Inherently some entity or person, i.e. the advertiser, must initiate this process. Further people inherently cannot be terminal devices; therefore they must be different from the terminal devices as claimed.
20. Applicant argues that Strietzel does not disclose receiving an acceptance signal because “Strietzel relates to phone calls and is silent as to the sending of a promotion message from a promotion server as claimed” and for this reason, “it necessarily follows that Strietzel is also silent as to receiving an acceptance signal relating to the sent promotion message” (see page 15 of Applicant’s response). As noted in the rejection above, Strietzel adequately discloses sending a message. Further Strietzel discloses in ¶0055 “...allowing the party to select to receive more information about a particular product or service... the user can actually select to be connected directly to the company offering the products or service” (emphasis added). The selection constitutes a signal that the user is accepting the offer in the promotion message. Additionally, as

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noted in the rejection, the promotion message relating to an event is taught by Reese (¶¶0015-0016) which also discloses acceptance signals as claimed. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

21. Applicant argues that Strietzel does not disclose associating an advertisement with a specific accepting communication terminal, but rather with a source at ¶0042, and further that ¶0042 and ¶0055 are not related. Applicant is reminded that Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. ¶0042 of Strietzel does specifically disclose that advertisement "may be associated with the destination terminal," further ¶0059, which is related to the embodiment discussed in ¶0055, discloses the same feature.
22. Applicant's final argument regarding claim 1 argues that Strietzel does not disclose sending a reminder. Applicant is reminded that, as noted in the rejection, the content of the message does not carry patentable weight in the claim, further Reese is relied on to teach message content because Reese discloses transmitting promotional information about events and reminder messages (see at least ¶¶0015-0016, "[t]he user is contacted at the appropriate time and destination with a message containing information associated with the event [t]his information may include a reminder about the event and/or information regarding a product, service, or other events associated with the event"). Further Examiner notes that in the context of a system claim, any server that is capable of sending any message will satisfy this limitation. As noted in the rejection, Strietzel discloses a messaging server that can send advertisements/messages over a

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network. Applicant repeats Applicant's argument that Strietzel's disclosure of phone calls serves as a patentable distinction between Applicant's invention and Strietzel. However, as Examiner noted above, Applicant's broad language and broad definitions in the specification, do not prevent Examiner from broadly interpreting Applicant's claim language to include phone communication. Examiner's claim interpretation is clarified above and is appropriate given Applicant's broad claim language and broad supporting disclosure; therefore Examiner's previous rejection of claim 1 is maintained.

- 23.** Applicant argues that the "communication terminal" of claim 19 is different from the router of Strietzel (see page 16 of Applicant's response). The recitation of "communication terminal" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Further, communication terminal may be broadly interpreted to mean any device capable of communication over the communication network, which would certainly include the router of Strietzel. Further, Strietzel discloses that the user device could be telephone, cellphone, PDA or computer (see at least ¶0056 of Strietzel).

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Conclusion

- 24.** Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 8:30am-4:00pm EST. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
- 25.** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
- 26.** Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to **571-273-8300**.

- 27.** Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building
401 Dulany Street
Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622
19 May 2009

/Arthur Duran/
Primary Examiner, Art Unit 3622